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In re Application of:	:	
LOSCALZO, Joseph, et al.	:	DECISION ON PETITION
U.S. Application No.: 10/692,724	:	UNDER 37 CFR 1.78(a)(3)
Filing Date: October 27, 2003	:	
Atty Docket No.: 102258-170 US3	:	
For: METHODS OF TREATING	:	
VASCULAR DISEASES	:	
CHARACTERIZED BY NITRIC	:	
OXIDE INSUFFICIENCY	:	

This is a decision on the "Renewed Petition Under 37 CFR 1.78" filed August 13, 2008. The petition seeks acceptance of an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of two prior-filed U.S. non-provisional application and two international applications designating the United States identified in the concurrently filed amendment and Supplemental Application Data Sheet (ADS). Applicant has previously paid the required petition fee.¹

The petition is **DISMISSED**.

37 CFR 1.78(a)(3) applies where an applicant seeks to add a late claim of benefit under 35 U.S.C. 120 and 365(c) to a prior-filed non-provisional or international application designating the United States. Applicant here is seeking to add priority claims to two non-provisional applications (U.S. applications 10/687,706 and 10/415,136) and two international applications (PCT/US01/14245 and PCT/US00/29582). Accordingly, the present petition is properly considered under 37 CFR 1.78(a)(3).

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii).

The present non-provisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

¹ It is noted that the renewed petition was accompanied by an additional petition fee. This second petition fee is not required and will be refunded to Deposit Account No. 08-0219.

A petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

The present petition fails to comply with item (1) above.

The amendment (and supplemental ADS) filed with the present petition fail to properly indicate the relationship between the two international applications. Specifically, the amendment and ADS indicate that PCT/US01/14245 “claims priority to” PCT/US00/29528. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part. See MPEP 201.11(III)(A):

Except for benefit claims to the prior application in a continued prosecution application (CPA), benefit claims under 35 U.S.C. 120, 121, and 365(c) must identify the prior application by application number, or by international application number and international filing date, and indicate the relationship between the applications. See 37 CFR 1.78(a)(2)(i). The relationship between the applications is whether the instant application is a continuation, divisional, or continuation-in-part of the prior nonprovisional application. An example of a proper benefit claim is “this application is a continuation of prior Application No. ---, filed ---.” A benefit claim that merely states that “this application claims the benefit of Application No. ---, filed ---” does not comply with 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i), since the relationship between the applications is not stated.

Before the petition under 37 CFR 1.78(a)(3) can be granted, a renewed petition under 37 CFR 1.78(a)(3) and a substitute amendment¹ or supplemental ADS (37 CFR 1.76) which properly sets forth the relationship of the prior-filed application(s) is required.

In addition, it is noted that another intermediate application herein fails to include the proper benefit claim. Specifically, the present application identifies U.S. application 10/679,257 as a “continuation” of U.S. application 09/697,317; however, U.S. application 10/679,257 is a “divisional” of 09/697,317, not a “continuation.” Accordingly, any revised amendment and/or supplemental ADS submitted by applicant herein should also correct this discrepancy.

Finally, it is noted that the “Foreign Priority Information” listed in the supplemental ADS is incorrect. Specifically, it is not proper to claim foreign priority to a domestic application (i.e., 10/415,136). Furthermore, the present application cannot claim foreign priority to

¹ Note 37 CFR 1.121

PCT/US01/14245, which was filed more than 12 months prior to the filing date of the present application. The ADS should be corrected accordingly.


Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Richard M. Ross at (571) 272-3296.


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